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HOLLAND & KNIGHT			EXAMINER	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JULIO ESTRADA, MIGUEL A. ESTRADA,
and MAURICE B. SHORE

Appeal 2008-005958
Application 09/473,098
Technology Center 2400

Decided: September 4, 2009

Before JAMES D. THOMAS, JOSEPH L. DIXON,
and STEPHEN C. SIU, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL
STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-7, 9, 10, 13, and 15. We have jurisdiction under 35 U.S.C. § 6(b).

We vacate the rejection of all claims on appeal under 35 U.S.C. § 103 and, within the provisions of 37 C.F.R. 41.50(b), institute a new ground of rejection of all claims on appeal under 35 U.S.C. § 101.

INVENTION

The invention provides for maintaining a collaboration space including a place comprising a plurality of rooms linked by pointers. A member directory for the place identifies users authorized to enter the place. Each room in the place includes one or more pages and a member's object for identifying members authorized to access a room, and for each member a level of authorization. (Spec. 18, ll. 2-9).

ILLUSTRATIVE CLAIM

Below is reproduced independent claim 3:

3. A collaboration space created as a web site by a user at a browser, comprising:

 a place comprising a plurality of rooms in a hierarchical structure linked by forward and backward pointers;

 a member directory for said place identifying users authorized to enter said place;

 each said room comprising one or more pages, and for each said room a members object for identifying a subset of members of said place authorized to access said room and for each member a level of authorization,

each member of said subset of members being a user authorized in said member directory to enter said place;

 said rooms including a parent room and a child room, and said pointers comprising forward and backward pointers for enabling the security of each said room to be independently managed, said forward pointers including indicia identifying said child room, indicia specifying the address location of the database forming said child room, and a readers field for providing access control list control on said forward pointer, said readers field for identifying those members of said subset of members of said place authorized to access a parent room that are also authorized to access a child room; and

 said collaboration space comprising a hierarchy of rooms, each room being a place in collaboration space including a member directory; said member directory, said members object, and said readers field selectively providing increased, decreased, and maintained access to a child place in collaboration space, with access at any level of authority to a child place enabled only for those authorized to access a corresponding parent place, and whether a link to a child place will be enabled for a specific user in its corresponding parent place.

PRIOR ART AND EXAMINER'S REJECTIONS

The Examiner relies on the following references as evidence of unpatentability:

Cutler	US 5,129,083	Jul. 7, 1992
Salas	US 6,233,600 B1	May 15, 2001 (filed Jul. 15, 1997)
Maurille	US 6,484,196 B1	Nov. 19, 2002 (filed Mar. 20, 1998)

Claims 1-7, 9, 10, 13, and 15, constituting all claims on appeal, stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the Examiner relies upon Salas in view of Maurille, further in view of Cutler.

ANALYSIS

At the outset, we vacate the Examiner’s rejection of all claims on appeal under 35 U.S.C. § 103. We do so because we conclude that the claims are “barred at the threshold by § 101.” *In re Comiskey*, 554 F.3d 967, 973 (citing *Diamond v. Diehr*, 450 U.S. 175, 188)(1981). Therefore, we reject all claims on appeal, claims 1-7, 9, 10, 13, and 15 as being directed to non-statutory subject matter.

The United States Supreme Court has held that a claim is not a patent-eligible “process” if it claims “laws of nature, natural phenomena, [or] abstract ideas.” *Diamond v. Diehr*, 450 U.S. 175, 185 (1981) (citing *Parker v. Flook*, 437 U.S. 584, 589 (1978) and *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972)). The subject matter of the present claims on appeal is clearly not a machine, a manufacture, a process, or a composition of matter permitted within 35 U.S.C. § 101. Moreover, our reviewing court has stated that “[t]he four categories [of § 101] together describe the exclusive reach of patentable subject matter. If the claim covers material not found in any of the four statutory categories, that claim falls outside the plainly expressed scope of § 101 even if the subject matter is otherwise new and useful.” *In re Nuijten*, 500 F.3d 1346, 1354 (Fed. Cir. 2007), *reh’g en banc denied*, 515 F.3d 1361

(Fed. Cir. 2008), *cert. denied*, __ U.S.__, 127 S. Ct. 70 (2008). *Accord In re Ferguson*, 2009 WL 565074, (Fed. Cir. 2009). This latter case held that claims directed to a “paradigm” are non-statutory under 35 U.S.C. § 101 as representing an abstract idea.

All claims on appeal, in particular beginning with each independent claim 1, 3, 9, 10, 13, and 15, variously recite a collaboration space, a place, rooms, an access control list or ACL, pointers, data objects, data hierarchies, directories and the like, each of which directly relates to abstract ideas or abstract intellectual concepts. These terms also relate to mere data constructs. Some of these terms are merely virtual data constructs of real-world elements or things, none of which are positively recited.

To the extent recited in each claim on appeal, the claimed browser is a software application as indicated at Specification page 6, line 9, and not a physical structure or location. The so-called collaboration space created by a browser “as a web site” is a data construct of a software entity where the web site so created is not a physical place. These considerations particularly apply to independent claims 1 and 3 on appeal.

On their face, method claims 9 and 10 purport to be statutory subject matter as a “process” within 35 U.S.C. § 101. The earlier-noted considerations apply equally well to these claims. The Supreme Court’s “machine-or-transformation test, properly applied, is the governing test for determining patent eligibility of a process under § 101.” *In re Bilski*, 545 F.3d 943, 956 (Fed. Cir. 2008) (en banc). “A claimed process is surely

patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing.” *Id.* at 954. The present versions of method independent claims 9 and 10 on appeal do not meet these requirements.

Lastly, we turn to the subject matter of independent claims 13 and 15 on appeal. The preambular recitation of a “computer program product” recites by its own terms a software product *per se*, not necessarily a machine or a tangible article of manufacture. The claimed “a computer readable medium” in the body of claim 15 does not require that a computer actually, in a present tense, read any medium. Moreover, the medium is not recited to be a tangible medium such as to embody a tangible article of manufacture. In fact, this claim recites in the body the plurality of first and second etc. program instructions which are directed to abstract software code *per se*, which is considered an intangible, an idea without physical embodiment.

Correspondingly, the functionalities recited in the body of independent claim 13 are consistent with the reasoning we have advanced earlier. The preambular recitation of tangibly embodying a program of instructions does not necessarily require any tangible medium but only that the instructions themselves may be physically detectable. There is no recitation of any machine that actually executes the instructions or, in the present tense sense, performs the method steps. A reader’s inference from the subject matter of independent claims 13 and 15 that may permit or otherwise be viewed as requiring the use of the machine is subjective and

passive, and does not necessarily indicate that statutory subject matter is actually recited. Indeed, such inferences require the reader to read into the claims what is not recited in them, including reading into the claims subject matter from the Specification as filed.

CONCLUSION AND DECISON

We have vacated the outstanding rejection of claims 1-7, 9, 10, 13, and 15 under 35 U.S.C. § 103. Within the provisions of 37 C.F.R. 41.50(b), we have rejected these claims as being directed to non-statutory subject matter within 35 U.S.C. § 101.

In addition to vacating the Examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides that “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

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(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

VACATED

37 C.F.R. § 41.50(b)

rwk

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